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**JAN 04 2008**

**OFFICE OF PETITIONS**

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PENISULA IP GROUP A PROFESSIONAL LAW CORPORATION  
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CORRAL DE TIERRA CA 93908

In re Application of :  
Waschura, et al. :  
Application No. 09/996,342 : DECISION  
Filed: 21 November, 2001 :  
Attorney Docket No. WASC1821 :

This is a decision on the petition filed on 11 August, 2006, resubmitted on 5 September, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, the petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

**NOTES:**

Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision.<sup>2</sup>

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<sup>2</sup> For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance mailed on 20 March, 2006, with reply due under a non-extendable deadline on or before 20 June, 2006;
- the application went abandoned after midnight 20 June, 2006;
- Petitioner filed an after-final amendment under 37 C.F.R. §1.312 on 27 March, 2006, which amendment appears not to have been entered by the Examiner;
- The record reflects an Examiner interview summary mailed on 29 March, 2006, reflecting a telephone conversation between Petitioner and the Examiner on 27 March, 2006;
- the Office mailed the Notice of Abandonment on 3 August, 2006;
- on 11 August, 2006, Petitioner filed the instant petition with, *inter alia*, an averment of that the Examiner's amendment accompanying the Notice of Allowance/Allowability on 20 March, 2006, was not agreed to by the Petitioner, and Petitioner wished to have reinstated his Appeal filed on 23 January, 2006 (Notice of Appeal actually filed in the form of an Appeal Brief) with fee authorized and charged), with the Appeal Brief resubmitted on 6 March, 2006 (with fee authorized but apparently not charged at that time because it appears that the credit card authorization form may not have been submitted at that time), and so it appears that the appeal may not have been perfected for the lack of the fee due on filing of the brief on 6 March, 2006;
- thereafter, inquiry by the Office of Petitions to the Examiner as to entry or not of the 27 March, 2006, after-final amendment resulted in the following excerpt from the Examiner's reply (through the Supervisory Patent Examiner of the art unit) (a copy of the reply is enclosed):

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A response to the 312 amendment would be that the amendment can not be entered under 312.

Here is the text of the response.

*The March 27, 2006, 37 CFR 1.312 amendment has been considered but is disapproved for the following reason. The amendment presents changes to the claims which would necessitate withdrawing the application from issue and as such may not be entered. An amendment under 312 is not to be used for the purpose of continuing prosecution. As this amendment restores the claims to a finally rejectable form, its entry is not proper use of an amendment filed under 312.*

*Examiner Lau's recollection of the events discussed in early March 2006 with respect to what transpired to result in an examiner's amendment and allowance of the instant application and the filing of a continuation differ from those of applicant.*

*The pertinent portions of 37 CFR 1.312 are reproduced here.*

*No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.*

*\*\*\*.*

Thus, the Examiner, through his Supervisory Patent Examiner, indicates that non-entry of the 27 March, 2006, after-final amendment under 37 C.F.R. §1.312 results, in part, because the 27 March, 2006, after-final amendment under 37 C.F.R. §1.312 was not a proper reply to the Notice of Allowance/Allowability of 20 March, 2006.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of

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representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>2</sup>

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>3</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>4</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup>

And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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<sup>2</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

See specifically, the regulations at 37 C.F.R. §10.18.

<sup>3</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>4</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup> (See, also, the commentary at MPEP §711.03(c)(I)(A) and (B).)

And the regulation requires that relief be sought within two (2) months of the act complained of.

Petitioner appears not to have satisfied the showing burdens herein.

CONCLUSION

Petitioner appears to have satisfied the burdens herein, and the petition as considered under 37 C.F.R. §1.181 is dismissed.

ALTERNATIVE VENUE

Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_711\\_03\\_c.htm#sect711.03c](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c) )

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:

By mail:        Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

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<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

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By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>9</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>9</sup> The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

<b>Response to Rule 312 Communication</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/996,342	WASCHURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tung Lau	2863	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

1. ☒ The amendment filed on 27 March 2006 under 37 CFR 1.312 has been considered, and has been:

- a) ☐ entered.
- b) ☐ entered as directed to matters of form not affecting the scope of the invention.
- c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

- d) ☒ disapproved. See explanation below.
- e) ☐ entered in part. See explanation below.

*The March 27, 2006, 37 CFR 1.312 amendment has been considered but is disapproved for the following reason.*

*The amendment presents changes to the claims which would necessitate withdrawing the application from issue and as such may not be entered. An amendment under 312 is not to be used for the purpose of continuing prosecution. As this amendment restores the claims to a finally rejectable form, its entry is not proper use of an amendment filed under 312.*

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/John E. Barlow Jr./  
John E Barlow Jr  
SPE TC 2800